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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

4461-040040

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on November 13, 2008

Signature

Lisa A. Miller

Typed or printed name Lisa A. Miller

Application Number

10/773,912

Filed

2/6/2004

First Named Inventor

Constantine A. Domashnev

Art Unit

3626

Examiner

Neal R. Sereboff

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.
Registration number 50,261

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

Alexander Detschelt

Signature

Alexander Detschelt

Typed or printed name

412-471-8815

Telephone number

November 13, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒

*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3600
Application No.: 10/773,912
Paper Dated: November 13, 2008
Attorney Docket No. 4461-040040

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/773,912 Confirmation No. : 7385
Applicant : Constantine A. DOMASHNEV
Filed : February 6, 2004
Title : **Electronic Prescription Handling System**
Group Art Unit : 3626
Examiner : Neal R. SEREBOFF
Customer No. : 28289

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

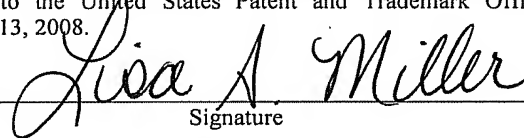
Sir:

For the reasons set forth herein, Applicant respectfully submits that the Final Office Action is based upon improper rejections of the claims and does not establish the asserted *prima facie* case of obviousness based on the cited references.

I hereby certify that this correspondence is being electronically submitted to the United States Patent and Trademark Office on November 13, 2008.

11/13/2008

Date



Signature

Lisa A. Miller

Typed Name of Person Signing Certificate

Response Under 37 CFR 1.116
Expedited Procedure
Examining Group 3600
Application No.: 10/773,912
Paper Dated: November 13, 2008
Attorney Docket No. 4461-040040

I. Rejection of claims 1 and 13 under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley

The Final Office Action dated September 30, 2008 fails to set forth a proper obviousness rejection with respect to claims 1 and 13 by dismissing the merits of the Declaration and by failing to provide a suggestion or motivation for one skilled in the art of ASP medical-based computing implementations to combine the teachings of the Munoz publication with those of the Henley publication.

With respect to the previously submitted Declaration, the Declaration does in fact relate to the individual claims of the application. The survey questions posed to the physicians directly relate to the invention because it is the answer to the questions that go toward addressing the long-felt need aspect of the claimed system. Specifically, with reference to page 7 of the previous response, Question 1 addresses the automation aspect embodied in claims 1 and 13 by virtue of it being implemented via computers; Question 2 addresses the universal accessibility of the portable storage medium of claim 17; and Question 5 addresses the auction aspect provided by the system allowing two or more pharmacy computers to retrieve the prescription from the service provider's server for purposes of bidding on the prescription, as set forth in claims 1 and 13. Therefore, Applicant does not understand how the Examiner can reasonably assert that the Declaration, incorporating the survey, as set forth in §2 of the Declaration, does not sufficiently address the specific claims.

The Examiner asserts that Applicant is simply making a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. However, Applicant has already done this in the context of addressing previous anticipation rejections. The current arguments, based upon the outstanding rejections, now address why it would not be obvious to combine the prior art references as set forth by the Examiner. Therefore, Applicant does not understand the Examiner's contention in this regard.

The Examiner rejects Applicant's "reverse auction" argument on the basis that Applicant has failed to explicitly claim this feature. However, as Applicant has previously indicated (See Response dated July 7, 2008, page 8, lines 31-36), this feature is inherent in

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the claim. The Examiner then submits that a “reverse auction” has various meanings, as shown in the “Dutch auction article” attached to the Office Action. However, this article only defines a Dutch auction as being the “reverse of the traditional auction model in which an auctioneer starts off with a high price...” It appears to Applicant that the Examiner simply sees the word “reverse” in the definition and, therefore, incorrectly, equates the Dutch auction with the term of art “reverse auction.” This has no bearing on Applicant’s choice to not explicitly claim a reverse auction. The Examiner then cites U.S. Patent Application Publication No. 2005/0065821 to Kalies for the purpose of showing the disclosure of reverse auction as it relates to pharmacy prescription bidding. However, first, the Examiner has not formally rejected the claims using this reference, and second, doing so at this point would clearly be indicative of the Examiner making an improper hindsight rejection in combining the teachings of prior art references by using the claimed invention as a template. In any case, Applicant has set forth in his Declaration (See Response dated July 7, 2008, page 9, line 21 to page 10, line 4) the rationale for why neither the Munoz nor Henley publication contains any suggestion or motivation to combine the teachings of these references.

Applicant hereby also incorporates by reference the following arguments made in the Response dated July 7, 2008:

The design choice rule of law does not apply and the advantage of the claimed invention by virtue of its service provider context is not appreciated by the Examiner (See page 7, line 16 to page 7, line 21).

The term “service provider” does not represent only an intended use of the claimed server, but is rather a recitation of a positive step in at least method claim 13 (See page 8, lines 22-30).

II. Rejection of claims 10 and 11 under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0052760 to Munoz et al. in view of U.S. Patent Application Publication No. 2003/0195838 to Henley, further in view of U.S. Patent Application Publication No. 2003/0154376 to Hwangbo, and further in view of U.S. Patent Application Publication No. 2002/0035484 to McCormick

Claims 10 and 11 relate to directions and mapping of the pharmacies, which is beneficial to the patient in making informed decisions as to which pharmacy to select at the time of making a bid. As discussed in §3(b) of Applicant’s Declaration, “[t]he patient’s decision will be based, among other things, on geographic location, proximity to commuting

routes...” Thus, providing directions and mapping of pharmacies, among other things, is not a single criteria choice (i.e., cost), as discussed in the Munoz publication. Furthermore, the motivation for combination of the teachings of the prior art provided by the Examiner is improper as it relates to “eliminating inefficiencies at the doctor’s office in generating the prescriptions”. Applicant fails to understand how providing directions and maps would improve on generating prescriptions more efficiently.

Applicant acknowledges the Examiner’s assertion of recent Supreme Court precedent, however, the Examiner fails to expound on why he believes that the results of the combination of existing elements would be predictable. Supreme Court precedent also requires that a rejection “on obviousness grounds cannot be sustained by mere conclusory statements,” which Applicant believes is the case here. By virtue of Applicant’s Declaration and arguments, Applicant had indicated how the prior art includes deficiencies, which would therefore not lend the teachings of the prior art to be combined. Additionally, Applicant had argued the advantages associated with the invention as set forth in claim 11. However, the Examiner completely fails to address the merits of the Declaration with respect to these issues. An Examiner must take into account secondary considerations offered in a Declaration in his obviousness analysis, which evidently, the Examiner has failed to do.

III. Rejection of claim 17 under 35 U.S.C. § 103(a) for obviousness over U.S. Patent Application Publication No. 2002/0065758 to Henley in view of U.S. Patent Application Publication No. 2001/0039503 to Chan and U.S. Patent Application Publication No. 2005/0039032 to Babowicz et al.

The Examiner’s motivation for combining the teaching of the Babowicz publication with that of the other references is illogical in the context of the claimed invention. Specifically, the Examiner states that the motivation would be to “provide local use of an authentication program running on the client, who reduces communications and processing demands of the server.” However, the Auto-Run feature has nothing to do with reducing communications and processing demands, either in Babowicz or the claimed invention. In fact, the purpose of providing the Auto-Run feature in Applicant’s invention is to automatically execute an application to transmit a digital certificate to the server. This action clearly does not reduce communications and processing demands regardless of whether the certificate were stored locally on a computer or on the portable medium.

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As discussed in the Response dated July 7, 2008, "[t]here is an unfulfilled need in the electronic prescription industry to provide a system and method for providing a physician with authenticated access to generate a prescription from any Internet-connected computer, whereby a patient for whom the prescription is written invites bidding on his or her prescription in order to realize cost savings over market-priced drugs in the context of multi-objective prescription choices" (See page 10, citing §5 of *Declaration*). Page 11 of the Response details the survey conducted by Applicant that demonstrates a long-felt need for Applicant's invention. The Examiner has failed to take into account this secondary consideration in his obviousness analysis.

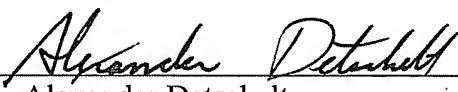
IV. Conclusion

The present invention is a novel and non-obvious way for providing a lower cost prescription to a patient by inviting bids for the prescription and generating a prescription from an Internet-connected computer. Applicant respectfully requests reconsideration of the rejections of the aforementioned claims in view of the arguments set forth herein.

Any questions regarding this submission should be directed to Applicant's undersigned representative, who can be reached by telephone at 412-471-8815.

The Commissioner for Patents is hereby authorized to charge any additional fees which may be required to Deposit Account No. 23-0650. Please refund any overpayment to Deposit Account No. 23-0650.

Respectfully submitted,
THE WEBB LAW FIRM

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